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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/810,956

03/26/2004

John C. Bischof

110.02150101

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11/17/2006

MUETING, RAASCH & GEBHARDT, P.A.  
P.O. BOX 581415  
MINNEAPOLIS, MN 55458

EXAMINER

TOY, ALEX B

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 11/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/810,956	<b>Applicant(s)</b> BISCHOF ET AL.	
	<b>Examiner</b> Alex B. Toy	<b>Art Unit</b> 3739	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 August 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 7-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                            |                                                                                         |
|--------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                       | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8/30/06</u> | 6) <input type="checkbox"/> Other: _____                                                |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed on August 30, 2006 with respect to the rejections of claims 1-6 have been fully considered and are persuasive. Therefore, the rejections have been withdrawn. However, upon further consideration, a new grounds of rejection are made.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Edwards (U.S. Pat. No. 5,472,441).

Regarding claim 1, Edwards discloses a method of performing a thermal surgical procedure, comprising:

identifying biological material to undergo the thermal surgical procedure

(Abstract);

contacting the biological material with an inflammation inducing composition, wherein inflammation is induced in at least a portion of the identified biological material (Abstract, col. 9, ln. 16-24, and col. 11, ln. 7-9, 43-44); and

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adjusting the temperature of the identified biological material, wherein at least a portion of the biological material is destroyed after undergoing the thermal surgical procedure (Abstract).

Regarding claim 3, Edwards further discloses that adjusting the temperature comprises raising the temperature above a physiological temperature of the biological material (Abstract).

Regarding claim 4, Edwards further discloses that the biological material is selected from the group consisting of cells, tissues, and combinations thereof (Abstract).

Regarding claim 5, Edwards further discloses that the cells are tumor cells (Abstract).

Regarding claim 6, Edwards further discloses that the tissues are selected from the group consisting of tumor tissues, liver tissue, prostate tissue, breast tissue, kidney tissue, vascular tissue, gastrointestinal tissue, muscle tissue, skin tissue, connective tissues, and combinations thereof (Abstract).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Daniel (U.S. PGPub 2002/0133148 A1) in view of Edwards ('441).

Regarding claim 1, Daniel discloses a method of performing a thermal surgical procedure, comprising:

identifying biological material to undergo the thermal surgical procedure (Abstract and pg. 20, ¶ 209);

contacting the biological material with a chemotherapeutic composition (pg. 8, ¶ 106, pg. 17, ¶ 179, and pg. 19, ¶ 197-198); and

adjusting the temperature of the identified biological material, wherein at least a portion of the biological material is destroyed after undergoing the thermal surgical procedure (pg. 4, ¶ 69).

The claim differs from Daniel in calling for the composition to induce inflammation in at least a portion of the identified biological material. Edwards, however, teaches an analogous device that ablates tumor tissue in combination with delivering a chemotherapeutic agent. Edwards further teaches that efficacious chemotherapeutic agents include inflammation inducing compounds (Abstract, col. 9, ln. 16-24, and col.

11, ln. 7-9, 43-44). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used an inflammation inducing chemotherapeutic composition in the method of Daniel in view of the teaching of Edwards as an obvious type of chemotherapeutic agent that is known in the art to be efficacious in combination with ablation treatment.

Regarding claim 2, Daniel further discloses adjusting the temperature to comprise lowering the temperature below a physiological temperature of the biological material (pg. 4, ¶ 69).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alex B. Toy whose telephone number is (571) 272-1953. The examiner can normally be reached on Monday through Friday, 8:00 AM to 4:30 PM.

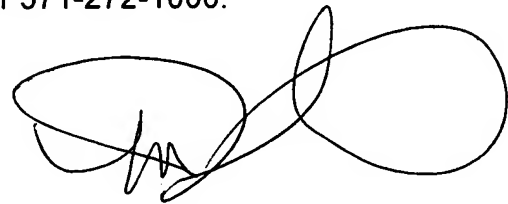
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AT *AT*  
11/13/06



LINDA C. M. DVORAK  
SUPERVISORY PATENT EXAMINER  
GROUP 3700